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| 09/448,804 | 11/24/1999 | DAVID L. SALGADO | D/99253-690 | 5473 |

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| EXAMINER |
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PANNALA, SATHYANARAYA R

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| ART UNIT | PAPER NUMBER |
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2164

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/05/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/448,804

Applicant(s)

SALGADO ET AL.

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

REOPENED

1. In view of the Appeal Brief filed on 11/16/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 as (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. Claims 1-21 are pending in this Office Action.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 12-14 are rejected under 35 U.S.C. 101, because none of the claims are directed to statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al. (USPA Pub. 2003/0159065) hereinafter Nakagawa, and in view of ("Strategy for Collecting Software Inventory Information Across a Local Area Network", IBM Technical Disclosure Bulletin, 12/1994) herein after IBM Disclosure, and in view of Schwarz, Jr. (US Patent 6,476,927).

7. As per independent claim 1, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital

data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the digital data based on the taken out copyright information page 1, paragraph [0010].

Nakagawa does not explicitly teach a system manager. However, Schwarz teaches the claimed step of “a system manager, the system being manager being adapted” as a central print server 14 (Fig. 9, col. 6, lines 42-46). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz's teachings would have allowed Nakagawa's method to minimize network loads, while providing central printer control. (col. 3, lines 58-60). Schwarz teaches the claimed step of “collecting attribute data from multiple platforms” as from the polling information, the printer server decides 78 if there is at least one compatible device 20 online (Fig. 7, col. 6, lines 1-3).

Nakagawa teaches the claimed step of “copyright data pertaining to software” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed step of “recognize the copyright data in the attribute data” as the step 12, reads from the attribute recording file 26, the last update (page 5, paragraph [0063]). Further, Nakagawa teaches the claimed step of “process the copyright data into a list of copyright data for the system” as taking out the information may involve selecting a method for taking out copy right information form the extension etc. of the filename of the digital data being the object of inspection (page 5, paragraph [0068]). Further, Schwarz teaches the claimed step of “a user interface connected to the system

manager for displaying the collected attribute data in the list to a user” as user interface for distribution of information to a receiver on a network (col. 3, lines 19-21). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz’s teachings would have allowed Nakagawa’s method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

8. As per dependent claim 2, Schwarz teaches the claimed step of “a user interface connected to the system manager for displaying attribute data in the list to a user” as user interface for distribution of information to a receiver on a network (col. 3, lines 19-21). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz’s teachings would have allowed Nakagawa’s method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

9. As per independent claim 3, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the digital data based on the taken out copyright information page 1, paragraph [0010]. Nakagawa does not teach polling at least platforms. However, Schwarz teaches the claimed step of “polling at least two platforms for attribute data” as the printer server 14

polls 76 the available printer devices 20 for their availability and current work load (Fig. 7, col. 5, line 67 to col. 6, line 1). Schwarz teaches the claimed step of “collecting the attribute data from the at least two platforms in response to the step of polling” as from the polling information, the printer server decides 78 if there is at least one compatible device 20 online (Fig. 7, col. 6, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz's teachings would have allowed Nakagawa's method to minimize network loads, while providing central printer control. (col. 3, lines 58-60). Further, Nakagawa teaches the claimed step of “displaying the collected attribute data on a user display” as the browser 22 provides an operating environment for a user carrying out the operation of the HTML document (Fig. 3, page 4, paragraph [0050]).

10. As per dependent claim 4, Nakagawa and Schwarz combined teaches independent claim 3. Schwarz teaches the claimed step of “collecting the attribute data from the at least two platforms in response to the step of polling” as from the polling information, the printer server decides 78 if there is at least one compatible device 20 online (Fig. 7, col. 6, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz's teachings would have allowed Nakagawa's method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

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11. As per dependent claim 5, Nakagawa teaches the claimed step of “step of polling at least two platforms for attribute data further comprises the step of polling at least one of the at least two platforms when polling is initiated by a user request” as the copyright of digital data provided by the data providing device is inspected and the information is taken from the device (Page 1, paragraph [0011] and paragraph [0049]).

12. As per dependent claim 6, Nakagawa teaches the claimed step of “the step of collecting the copyright information from the at least two platforms” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]).

13. A method as in claim 7, Nakagawa and Schwarz combined teaches independent claim 3. Nakagawa does not explicitly teach license information. However, Schwarz teaches the claimed step of “the step of collecting the attribute data from the at least two platforms in response to the step of polling further comprises the step of collecting the license information from the at least two platforms” as user interface for the distribution of information to a receiver on a network (col. 3, lines 20-23). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz’s teachings would have allowed Nakagawa’s method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

14. As per dependent claim 8, Nakagawa teaches the claimed step of “the step of storing the attribute data in non-volatile memory” as in the database 12 is stored documents described by HTML (page 4, paragraph [0047]).

15. As per dependent claim 9, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of automatically displaying the attribute data collected from the at least two platforms” as carries out automatic copyright inspection with respect to plurality of HTML documents (page 4, paragraph [0050]).

16. As per dependent claim 10, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of manually displaying the attribute data collected from the at least two platforms” (page 1, paragraph [0007] and paragraph [0049]).

17. As per dependent claim 11, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of displaying only non-copyright attribute data collected from the at least two platforms” as the step 12, reads from the attribute recording file 26, the last update (page 5, paragraph [0065 & 67]).

18. As per independent claim 12, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the digital data based on the taken out copyright information (page 1, paragraph [0010]). Schwarz teaches the claimed step of “a system controller for collecting the data form multiple platforms” as the central printer server 14 for the polling information and the printer server decides 78 if there is at least one compatible device 20 online (Fig. 7, col. 6, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz’s teachings would have allowed Nakagawa’s method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

Further, Nakagawa teaches the claimed “collecting the software copyright data” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed “a user interface connected to the system controller for displaying the software copyright data from the memory to a user” as inspection of copyright may be executed once a week, at 12 o’clock each Saturday, then the load on the user carrying out inspection of copyright can be reduced and also the inspection of copyright can be effectively carried out (page 6, paragraph [0088]).

19. As per dependent claim 13, Nakagawa teaches the claimed “the system controller for collecting the software copyright data from multiple platforms further comprises a memory for storing the software copyright data collected by the system controller” as attribute recording file (page 5, paragraph [0063]).

20. As per dependent claim 14, Nakagawa teaches the claimed “the memory for storing the software copyright data collected by the system controller further comprises non-volatile memory” as magnetic disk, magnetic drum, etc (page 6, paragraph [0089]).

21. As per dependent claim 15, Nakagawa teaches the claimed “the system manager collects attribute data from multiple platforms simultaneously” (page 6, paragraph [0088]).

22. As per dependent claim 16, Nakagawa teaches the claimed “the attribute data collected is attribute data stored on the multiple platforms and is passed to the user interface” (page 4, paragraph [0050]).

23. As per dependent claim 17, Nakagawa teaches the claimed “the list is a list of copyright years for the system in its entirety” as the attributes of the digital data the last update date (Fig. 5, page 4, paragraph [0050]).

24. As per dependent claim 18, Nakagawa teaches the claimed “the attribute data comprises copyright and license data related to software” as the copyright inspection software 24, at the time of inspecting whether or not the digital data for which one holds the copyright is being used improperly (page 4, paragraph [0050]).

25. As per dependent claim 19, Nakagawa teaches the claimed “the attribute data is a list of copyright years related to each software object of the system” as the attributes of the digital data the last update date (Fig. 5, page 4, paragraph [0050]).

26. As per dependent claim 20, Nakagawa teaches the claimed “the multiple platforms comprise document processing apparatus” as the WWW server 10 and the client 20 are computers incorporating at least a central processing unit (CPU) and a memory, which execute programs in the memory (Fig. 1, page 4, paragraph [0046]).

27. As per dependent claim 21, Nakagawa teaches the claimed “the attribute data comprising copyright data for each software object on each platform” as the copyright inspection software 24, at the time of inspecting whether or not the digital data for which one holds the copyright is being used improperly (page 4, paragraph [0050]).

Response to Arguments

28. Applicant's arguments filed on 11/16/2006 have been fully considered but they are moot in view of new reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

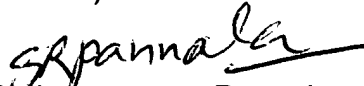
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sathyanarayan Pannala
Primary Examiner

srp
March 29, 2005

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER